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EXAMINER

YU, J

ART UNIT

PAPER NUMBER

3764

16

DATE MAILED:

10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/310,965

Applicant(s)

SCHALL, STAN

Examiner

J. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 5, 11, 12, and 17-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 10, 14, and 16 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 13, 15, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. This office action is responsive to the amendment filed on 7/9/01. As directed by the amendment, claims 4, 6, 10, 13, 15, and 16 were amended, no claim was canceled, and claim 21 was added. Thus, claims 1-21 are presently pending in this application.

In addition, claims 5, 11, 12, and 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The specification fails to provide adequately teach how to make and use the invention, i.e., fails to provide an enabling disclosure of means for rotating the platform. Notes that the term "means for rotating the platform" is suggested a mechanism for rotating the platform, i.e., a motor driving mechanism. It is the examiner's position that a bearing element can not be used for rotating the platform.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishow (Pat. No. 4,193,592) in view of Montgomery (Pat. No. 5,226,868) and Karstadt (Pat. No. Des. 141,456).

Bishow teaches a rocking/turning device comprising an upper platform 12, a lower housing 24 connected to the upper platform via regulating components (20, 28) and lower housing cap 14, and further including a bearing element 22.

Bishow in figure 5 shows handles 16 each having two uprights. Bishow does not explicitly disclose one of the uprights is taller than the other. However, Montgomery teaches a handle having an inclined gripping portion 88 being connected between a tall upright portion and a short upright portion (column 4, lines 47-49). Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modified Bishow's handle with an inclined hand gripping portion as taught by Montgomery, in order to provide comfort to the user.

The modified Bishow's handle lacks a tapered gripping area. However, Karstadt teaches a handle having a tapered configuration. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified Bishow's handle with a tapered structure as taught by Karstadt, since it is a matter of design and well known in the handle art to conform to the user's hand.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bishow in view of Montgomery and Karstadt as applied in claim 1 above, and further in view of Zetocha et al (Pat. No. 5,683,337).

Bishow teaches individual bearings 22 but lacks a bearing element having an opening passing therethrough. However, Zetocha teaches a bearing element having an opening passing therethrough. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bishow's bearings with the bearing element having an opening passing therethrough as taught by Zetocha, since such bearing structure is notoriously old and well known in the art.

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anber (Pat. No. 3,593,994).

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Anber teaches an exercise device comprising an upper platform 10, a lower housing 11 including a hole (figure 2), a bearing element 23, a lower housing cap 16, regulating components (bolt 25 and nut 26) including an adjustment mechanism 26. Anber does not explicitly disclose that the nut 26 being accessible through the hole in the floor (bottom surface) of the lower housing. However, the feature of choosing the nut accessible from the lower housing rather than having the head of the bolt accessible from the lower housing is considered as an obvious design choice since Anber's device would perform equally well with either way around.

Regarding claim 7, figure 2 of Anber shows the combination of the bolt 25 and the nut 26 forming the friction material which being variably set to provide a range of resistance levels.

Regarding claim 8, figure 2 of Anber shows the footing 13.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anber in view of Zetocha et al (Pat. No. 5,683,337).

Anber lacks a detail description that the bearing element having an opening passing therethrough. However, Zetocha in figure 3 shows a bearing element 50 having a opening. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Anber's bearing element with opening as taught by Zetocha, since such feature is notoriously old and well known in the art.

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10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anber in view of Bonewitz (Pat. No. 3,100,639).

Anber in figure 2 shows the upper platform being connected to the lower housing via bolts and nuts. Anber lacks a pad being attached to the upper surface of the upper platform. However, Bonewitz teaches a ribbed rubber pad 27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Anber's upper platform with a ribbed rubber pad as taught by Bonewitz, so as to prevent slippery.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, Jr (Pat. No. 4,768,778) in view of Ward, III (Des. 374,045) and Preston (Des. 120,140).

Thomas teaches an exercises device comprising an upper platform (52, 86, 34), a lower housing 22, a lower housing cap 36, a bearing element 38 and a handle(28, 26). Thomas lacks a handle having a short upright portion, a tall upright portion, and a gripping area being tapered from the short upright portion to the tall upright portion. However, Ward teaches a handle with an inclined hand gripping area connected between a tall and a short upright portions. In addition, Preston teaches it is a design consideration for providing a tapered hand gripping area. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thomas's handle with an inclined and tapered hand gripping area as taught by Ward and Preston, in order to provide comfort to the user.

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The modified Thomas's device has the same structure as claimed. It would have been obvious to a skilled artisan to perform the recited steps upon seeing the modified Thomas's device.

Response to Arguments

12. Applicant's arguments filed 7/9/01 have been fully considered but they are not persuasive.

Applicant on page 9 of the remarks argues that the specification described the bearing element allowing the rotation of the upper housing relative to the lower housing. While it is true that the specification discloses the bearing element, however, it is the examiner's position that the bearing element can not be used as "**means for rotating** the platform" because the bearing elements merely allowing the rotation of the platform. In addition, nowhere in the specification mentioned that the bearing element being used **to rotate** the platform. Therefore, the rejection still stands.

Applicant on page 16 of the remarks argues that Bishow fails to teach the large protuberance 24 engaging the upper platform 12. The examiner disagrees because figure 3 of Bishow clearly shows the large protuberance 24 being engaged to the upper platform 12 via shaft 20 and nut 28.

Applicant objects to the combination of Bishow and Montgomery references and states that Montgomery teaches away from using the disclosed handles on a device allowing for rotation. The argument is not well taken because first, nowhere in Montgomery discloses that the inclined handle can not be used in a rocking/turning device. Next, the manner of function of

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Montgomery's push-up board 14 is not particularly relevant here, however, in that Montgomery reference is only relied upon for its teaching that the handle may be inclined with a taller upright and a shorter upright. Applicant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a person of ordinary skill in the art could have readily appreciated that the Bishow's handle could be inclined in view of the Montgomery teaching.

Applicant on page 16 of the remarks requested the examiner provide proof to support the handle structure which is within the knowledge of one skilled in the art. Therefore, claims 1-3 are rejected under Bishow (Pat. No. 4,193,592) in view of Montgomery (Pat. No. 5,226,868) and Karstadt (Pat. No. Des. 141,456).

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Allowable Subject Matter

13. Claims 4, 10, 14, and 16 are allowed over the prior art of record.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justine Yu whose telephone number is (703) 308-2675. The examiner can normally be reached on Tuesday - Friday from 8:30 AM - 6:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Everett Williams whose telephone number is (703) 305-1708.


Justine Yu

October 9, 2001